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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,291	09/20/2000	Eyal Goldwerger	30485-181800	1801

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Dorsey & Whitney LLP  
1001 Pennsylvania Ave N W  
Suite 300 South  
Washington, DC 20004

EXAMINER
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PWU, JEFFREY C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 11/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Application/Control Number: 09/665,291  
Art Unit: 3624

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The period for reply of \*\*3\* MONTHS set in said Office Action is restarted to begin with the mailing date of this letter.

JACKIE WALDO  
HEAD SUPERVISORY, LEGAL INSTRUMENTS EXAMINER  
*TC 3600 703-308-3502*

# Office Action Summary

Application No.

09/665,291

Applicant(s)

GOLDWERGER, EYAL

Examiner

Jeffrey Pwu

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 6) ☐ Other: \_\_\_\_

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### DETAILED ACTION

1. This action is responsive to the amendment, filed 2000-09-20.
2. The disposition of claims is: claims 1-47 are pending as filed. Claims 1, 34, and 39 are independent.
3. The group art unit of the Examiner handling your case has changed. The new art unit is **3628**. Please use current art unit on all correspondence to help us route your case in a timely fashion.

#### *Claim Rejections - 35 USC § 101*

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-33 and 39-47 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. The claimed invention is noted not to be a computer program, data structure, a natural phenomenon, and a non-descriptive material per se. Furthermore, the claimed invention do not produce a useful, concrete and tangible result therefore they are nonstatutory. The claimed invention also is not a product for performing a process, nor it is a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction.

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As to the technology requirement, note MPEP Section iV 2(b). Also note *In Re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". *In re Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirements.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

- 1) In the claim, the practical application of an algorithm or idea result in a useful, concrete, tangible result, AND
- 2) The claim provides a limitation in the technological art that enables a useful, concrete, tangible result.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 1-47 are rejected under 35 U.S.C. 102(e) as being unpatentable over Barni et al.(applicant disclosed prior art; hereinafter Barni) (U.S. 6,064,981).

Barni discloses claims:

1. A method of creating a business to business exchange for shipments, the method comprising:  
a shipper specifying shipping requirements that comprise information that describes a requested shipping service and a commodity to be shipped (42, 44, 46); and  
initiating an auction for the requested shipping service as described by the shipping requirements, wherein the auction allows service providers to place bids in an attempt to secure a contract to perform the requested shipping service (fig.7).
2. The method of claim 1, wherein one or more auctions have been initiated, the method further comprising:  
viewing the one or more auctions (steps of figs. 6-10), the viewing comprising a service provider examining at least one shipping requirement of at least one auction.
3. The method of claim 2, further comprising the service provider selecting one of the one or more auctions in order to place a bid on the selected auction (steps of figs. 6-10).
4. The method of claim 2, further comprising the service provider placing a bid on one of the one or more auctions, wherein the bid includes a price and one or more price components that identify what features are included in the price (steps of figs. 6-10).
5. The method of claim 2, further comprising filtering the one or more auctions according to criteria specified by the service provider, wherein the specified criteria correspond to certain shipping requirements (42', 44', 46').
6. The method of claim 2, further comprising sorting the one or more auctions according to a criteria selected by the service provider, wherein selected criteria corresponds to a certain shipping requirement (42', 44', 46').

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7. The method of claim 1, wherein a plurality of bids that include one or more price components have been placed on the auction, the method further comprising the shipper completing the auction by accepting one of the bids (abstract; "as many of the bids records as possible...").
8. The method of claim 7, wherein one or more of the plurality of bids includes a lower price than the accepted bid (it is inherent in a bidding process).
9. The method of claim 1, further comprising notifying a service provider of the auction, wherein the service provider has specified criteria for notification and the auction meets the specified criteria (col.2, lines 1-38).
10. The method of claim 1, wherein a bid that includes one or more price components has been placed on the auction, the method further comprising notifying the shipper that the bid has been placed on the auction (col.2, lines 1-38).
11. The method of claim 1, wherein the method is conducted over a communication medium (10).
12. The method of claim 11, wherein the communication medium is the Internet "A plurality of Internet client machines 10").
13. The method of claim 12, wherein the method is conducted with at least one server and at least one user machine including a display, the method further comprising accessing via the display a screen to create an auction (col.3, line 14-col.4, line 57).
14. The method of claim 1, wherein a plurality of auctions have been initiated, the method further comprising monitoring the initiated auctions (it is inherent that all computer transactions can be monitored by a network server).
15. The method of claim 1, further comprising approving the initiated auction, thereby making the initiated auction a live auction available for bidding (online; real-time).
17. The method of claim 16, wherein the managing the live auction comprises inviting a bid from a service provider (col.2, lines 12-38).

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18. The method of claim 16, wherein the live auction has an expiration time and the managing the live auction comprises extending the live auction past the expiration time (it is inherent that a live auction has an expiration time)
19. The method of claim 15, wherein the live auction closes due to the lack of an acceptance of a bid, the method further comprises managing the closed auction (col.7, line 27-col.8, line 40).
20. The method of claim 1, wherein the specifying includes specifying within the shipping requirements an indication of a shipping route (fig.4).
21. The method of claim 1, wherein the specifying includes specifying one of the following for the shipping service: a LCL one-time shipment, a FCL one-time shipment or a service contract (fig.4).
22. The method of claim 1, wherein the specifying includes specifying within the shipping requirements an indication of a number of containers required (figs. 4-12).
23. The method of claim 1, wherein the specifying includes indicating a corresponding code for the commodity (figs. 4-12).
24. The method of claim 1, wherein the specifying includes indicating within the shipping requirements whether the commodity is hazardous ('contents'-fig.2).
25. The method of claim 1, wherein the specifying includes indicating within the shipping requirements a penalty per container (36).
26. The method of claim 1, wherein the specifying includes indicating within the shipping requirements a size of container (cargo bids description).
27. The method of claim 1, further comprising the shipper indicating a range of acceptable bids (see "auction bloc").
28. The method of claim 4, further comprising indicating shipping terms within the price components (see shipping lane).



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29. The method of claim 1, wherein a plurality of bids comprising a price, price components and a service provider identity are placed on the auction, the method further comprising displaying the plurality of bids so that the shipper can view the plurality of bids (figs. 4-12).
30. The method of claim 1, wherein a plurality of bids, each bid comprising a price, price components and a service provider identity, are placed on the auction by a plurality of service providers, the method further comprising displaying the plurality of bids so that a service provider can only view the price and price components of the bids of other service providers (figs. 4-12).
31. The method of claim 1, wherein a bid has been placed on the auction by a service provider and has been accepted by the shipper, the method further comprising the shipper providing feedback on the service provider, the feedback comprising a rating of the service provider (figs. 4-12).
32. The method of claim 1, wherein the shipper is any one of the following: an ~~importer~~, exporter, shipping association or a NVOCC.
33. The method of claim 2, wherein the service provider is any one of the following: an ocean carrier, a ocean carver's agent, a freight forwarder (see shipping).

(Claims 34-47 are similarly rejected as in claims 1-33)

34. An online shipping exchange comprising:  
a server that hosts the online shipping exchange, comprising: a secondary storage device; and  
a connection to a network, wherein the server can be accessed from the network;  
a user machine, that enables user access to the server, comprising: a display;  
an input device; and  
a connection to the network, wherein the user machine can access the server through the network; and  
a plurality of screens, that are supported by the server and presented on the display, comprising:  
a create-an-auction screen, that enables a first user to enter shipping requirements to create an auction, wherein shipping requirements comprise information that

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- describes a requested shipping service and the create-an-auction screen comprises sections for entering the shipping requirements, the sections including a commodity section; and  
an auction detail screen, that enables a second user to place a bid on the auction, wherein the auction detail screen includes the shipping requirements for the auction.
35. The online shipping exchange of claim 31, further comprising:  
a view all requests screen that comprises pending shipping services auctions, wherein the view all requests screen allows the second user to view the pending shipping services auctions.
  36. The online shipping exchange of claim 31, wherein the auction detail screen comprises a section that includes bids placed on the shipping services auction, so that the first user can determine whether to accept one of the placed bids.
  37. The online shipping exchange of claim 31, wherein the first user is a shipper and the second user is a service provider.
  38. The online shipping exchange of claim 31, wherein the shipping services comprise a LCL shipment, a FCL shipment or a services contract.
  39. A method operative at a server for creating a business to business exchange f o r shipments, the method comprising:  
displaying a list of live auctions for shipping services that are available for bidding;  
identifying a commodity being shipped for each of the live auctions; storing a bid placed on one of the live auctions, wherein the bid includes price components; and displaying the bid so that a first user may evaluate the bid.
  40. The method of claim 36 further comprising notifying a second user that an auction that meets criteria specified by the second user is available for bidding.
  41. The method of claim 40, wherein the notifying comprises sending an E-mail message to the second user.
  42. The method of claim 36 further comprising notifying the first user that a bid

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has been placed on an auction submitted by the first user.

43. The method of claim 42, wherein the notifying comprises sending an E-mail message to the first user.
44. The method of claim 39, wherein the first user is a shipper.
45. The method of claim 44, wherein the shipper is a NVOCC.
46. The method of claim 40, wherein the second user is a service provider.
47. Wherein the service provider is a NVOCC.

☞ Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeffrey Pwu whose telephone number is (703) 308-7835.



10 November 2003

**JEFFREY PWU**  
**PRIMARY EXAMINER**